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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILBERT ROBERT GERMAINE

Appeal 2009-011658
Application 10/519,250
Technology Center 1700

Before CHARLES F. WARREN, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-4. We have jurisdiction pursuant to 35 U.S.C. § 6.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellant's claimed invention is directed to preparing medicinal or technical white oil by contacting a Fischer-Tropsch (FT) derived paraffinic bottom product with a heterogeneous adsorbent, such as active carbon.

Claim 1 is illustrative and reproduced below:

1. A process for the preparation of medicinal white oil or a technical white oil from a Fischer-Tropsch derived paraffinic distillate bottom product, comprising contacting the bottom product with a heterogeneous adsorbent.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Benazzi	WO 01/81508 A1	Apr. 20, 2001 ²
Biscardi	US 6,579,441	Jun. 17, 2003

The Examiner maintains the following grounds of rejection:

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Benazzi in view of Biscardi.

The dispositive issue before us is:

Has Appellant indicated error in the Examiner's determination that an ordinarily skilled artisan would have been led to interpose heterogeneous adsorbent treatment of FT derived paraffinic bottoms downstream of

² Appellants rely on U.S. Patent No. 6,884,339 as an English language equivalent of Benazzi. U.S. Patent No. 6,884,339 issued from the U.S. National Stage Application No. 10/018,526 of International Application No. PCT/FR01/01221 with an international filing date of April 20, 2001. Benazzi is the World Intellectual Property Organization publication of the same International Patent Application (WO 01/81508 A1). Also, of record, is a copy of an English language translation of Benazzi, by McElroy Translation Company. There is no English language translation dispute.

Benazzi's catalytic dewaxing step and before or after Benazzi's hydrofinishing step based on the combined teachings of Biscardi and Benazzi to reduce haze precursors, and ultimately haze, in Benazzi's white oil final product?

We answer this question in the negative and we affirm the stated rejection for substantially the reasons and factual findings set forth by the Examiner in the Examiner's Answer. We offer the following for emphasis.

Appellant argues the appealed claims together as a group. Accordingly, we select claim 1 as the representative claim, on which we decide this appeal.

At the outset, we note that representative claim 1 is open to the inclusion of additional steps. In this regard, the employed transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *See Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376 (Fed. Cir. 2004). Thus, the representative claim 1 process does not require but may include additional steps both before and after the adsorbent contacting step. Moreover, the limitation "Fischer-Tropsch derived paraffinic distillate bottom product" embraces any paraffin-containing bottom product that ultimately could be derived using a "Fischer-Tropsch" type synthesis as at least a part of the bottom product generation method.³

³ Methods of preparing hydrocarbons from carbon monoxide and hydrogen at elevated temperatures and pressures over an effective catalyst are well-known (*see, e.g.*, Spec. 2, ll. 8-10; Biscardi, (col. 3, ll. 55-65)). A hydrocarbon synthesis process using this pathway is called a "Fischer-Tropsch" synthesis process, being named after F. Fischer and H. Tropsch.

The Examiner has found without dispute that Benazzi teaches or suggests a method of forming high quality oils, such as medicinal white oil, from a paraffinic distillate bottoms product (Ans. 4, App. Br. 2-3). The Examiner notes that Benazzi's method includes a catalytic dewaxing step (Ans. 4). The Examiner has further determined, without specific dispute, that one of ordinary skill in the art would have recognized that Benazzi's disclosure encompasses or would have suggested the use of an FT derived paraffinic distillate bottom product as at least part of the feedstock/bottoms hydrocarbon distillate employed for forming the ultimate high quality product, such as the medicinal white oil (Ans. 4-5; *see generally* App. Br.).

Benazzi is not relied upon by the Examiner for disclosing or suggesting the claimed adsorbing step. Rather, the Examiner turns to Biscardi for disclosing adsorption with a heterogeneous adsorbent such as clay or active carbon as a method of treating base oils, including base oil subjected to a catalytic dewaxing treatment step, to remove haze precursors therefrom (Ans. 5; Biscardi, col. 3, l. 32- col. 4, l. 1, col. 5, ll. 7-51, col. 7, l. 44- col. 8, l. 33, and col. 10, ll. 11-29). Biscardi discloses that FT derived distillate feedstock can be subject to catalytic dewaxing and haze reducing adsorption therein (col. 5, ll. 24-50). The Examiner notes that Biscardi teaches that "haze precursors tend to be more abundant in oil that has been catalytically dewaxed (see Biscardi, column 5, lines 1-12)" (Ans. 5).

Given the above, the Examiner has reasonably determined that it would have been obvious to one of ordinary skill in the art to introduce an adsorption step as taught by Biscardi subsequent to the catalytic dewaxing step of Benazzi in order to recover a medicinal white oil that is upgraded by

having reduced haze precursors or reduced haze formation potential therein with a reasonable expectation of success in so doing (Ans. 5-9).

Appellant argues that Biscardi addresses the problem of haze formation and there is no reason to add an adsorption step [for color] to Benazzi to the extent Benazzi obtains a medicinal white oil meeting color and UV absorbance criteria via the process thereof (App. Br. 3-4). However, Appellant's argument misses the mark because the incentive reasonably advanced by the Examiner for an artisan to employ the adsorbent treatment step in Benazzi is not for color removal to meet a white oil color (Saybolt color) requirement as seemingly argued.

In this regard, the Examiner relies on Benazzi for teaching or suggesting medicinal white oil formation from a variety of feedstocks, which would be inclusive or suggestive of an FT derived paraffinic bottoms product feedstock, as discussed above and in the Examiner's Answer. The medicinal white oil would possess the required Saybolt color value, via the combination of steps, including catalytic dewaxing and hydrofinishing, taught or suggested by Benazzi. Appellant's argument does not indicate error in the Examiner's reasonable determination that one of ordinary skill in the art would have been led to add Biscardi's adsorption step to the white oil manufacturing process of Benazzi to upgrade the white oil with a lower haze formation potential by lowering the amount of haze precursors therein as taught by Biscardi to be expected (Ans. 5, 6, 8, and 9). *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996) and *In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990) (*en banc*) (the motivation to combine the prior art references need not be identical to that of Applicant).

On this record, we affirm the stated obviousness rejection.

ORDER

The Examiner's decision to reject claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Benazzi in view of Biscardi is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

sld

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